

AMENDMENT UNDER 37 C.F.R. § 1.111  
U.S. Appln. No.: 10/043,328  
Attorney Docket No.: Q68052

### **REMARKS**

With this Amendment, Applicants add new claims 32-33, and amend claims 1, 3, 9-11, 16-17, 22 and 28. No new matter is added. Therefore, claims 1-33 are all the claims currently pending in the present application.

#### **I. Formal Matters**

Applicants thank the Examiner for acknowledging their claim to foreign priority and for confirming that the certified copy of the priority document was received.

Applicants thank the Examiner for indicating his approval of the drawings during a telephone call on November 3, 2004.

#### **II. Objection to Information Disclosure Statement (IDS)**

In the Office Action, the Examiner indicates that the references listed on form PTO/SB/08 A & B (Japanese Unexamined Patent Application Publication No. H07-087568, Japanese Unexamined Patent Application No. 2001-008271, and Japanese Unexamined Patent Application No. 2002-218535) have not been considered, allegedly because Applicants' IDS filed April 7, 2004, did not "include a concise explanation of the relevance" as required by 37 C.F.R. § 1.98(a)(3) (*See* page 2 of the Office Action).

Applicants respectfully submit that the concise explanation requirement has been fully met by providing an English language translation of those portions of a corresponding Japanese Patent Office Action (dated January 9, 2004 citing the references mentioned above) which indicate the degree of relevance found by the Japanese Patent Office. In particular, MPEP § 609(A)(3) provides that:

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Where the information listed is not in the English language, but was cited in a search report or other action by a foreign patent office in a counterpart foreign application, the requirement for a concise explanation of relevance can be satisfied by submitting an English language version of the search report or action which indicates the degree of relevance found by the foreign office. (*Id.*)

Therefore, the Examiner's failure to consider the above-mentioned Japanese language references when originally submitted with the IDS filed April 7, 2004, was contrary to the directive clearly set forth in MPEP § 609(A)(3). Accordingly, Applicants respectfully request that this error on the part of the Examiner be corrected by considering the references mentioned above.

Notwithstanding the fact that an English language translation of the relevant portions of the Japanese Patent Office Action (dated January 9, 2004 citing the references mentioned above) was originally submitted April 7, 2004, Applicants are enclosing, for the Examiner's convenience, an entire copy (including U.S.P.T.O. stamped filing receipt) of the IDS filed on April 7, 2004.

Additionally, the Examiner is requested to return an initialed form PTO/SB/08 A & B (enclosed herewith for the Examiner's convenience) which lists the references mentioned above.

### **III. Objections to the Claims**

The Examiner objected to claims 9 and 22 because some of the terms do not have clear antecedent basis. Applicants submit that the amendments to claims 9 and 22 overcome the objection. Also, such amendments do not change the scope of claims 9 and 22.

**IV. Rejection under 35 U.S.C. § 102(e) over Linkola**

Claims 1, 2, 8, 28, 29, and 31 stand rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by Linkola et al. (U.S. Patent No. 6,708,033). For the following reasons, Applicants respectfully traverse this rejection.

**Claim 1**

Linkola et al. fails to disclose or suggest at least a communication limiter, which identifies whether the location of a user terminal is within a use prohibition area, where communications of the user terminal are not allowed, the prohibition area being a portion of a cell zone, as recited in claim 1. Additionally, Linkola fails to disclose or suggest that the communication limiter transmits disconnect instructions to a user terminal when the user terminal is within the use prohibition area, as claimed.

The Examiner alleges that column 6, lines 3-51 of Linkola discloses the features recited in claim 1. Applicants respectfully submit that the features recited in claim 1 are not disclosed, taught or suggested by Linkola.

In contrast to the invention of the present application, Linkola is directed to a system for changing a service profile of a mobile subscriber when a mobile station moves from one location area (e.g. LAI a of Fig. 1) to another location area (e.g. LAI b of Fig. 1).<sup>1</sup> In order to locate the mobile station of a mobile subscriber, Linkola discloses a location part (31). The location part

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<sup>1</sup> See Col. 1, lines 35-38 of Linkola explaining that a location area is the geographic area covered by base transceiver stations in which a mobile station *may operate* and that “[t]he mobile station may move” into different location areas.

(31) locates the mobile station by evaluating parameters corresponding to a signal transmitted from a base transceiver station. (Col. 8, lines 16-20). The parameters contain data corresponding to cell identity and a location area code. (Col. 8, lines 6-15). The location area code merely specifies the location area identity (LAI) where the mobile station is located within a public land mobile network (PLMN).<sup>2</sup> (Col. 2, lines 14-20). The location part (31) sends the location area code data to an evaluation part (32). When the evaluation part (32) determines that the mobile station moved from one location area (e.g. LAI a) to another location area (e.g. LAI b), it sends a subscriber connection exchange part (33) a command to exchange the connection on the PLMN so that a mobile subscriber's service profile can be updated. There is no teaching or suggestion, however that the location part (31) identifies whether the location of a user terminal is within a use prohibition area, where communications of the user terminal are not allowed, the prohibition area being a portion of a cell zone, as recited by claim 1.

For at least these reasons, Linkola fails to disclose, teach or otherwise suggest the features recited in claim 1. Accordingly, Applicants submit that Linkola fails to anticipate claim 1, and Applicants respectfully request the Examiner to withdraw the §102(e) rejection of claim 1.

#### **Claims 2 & 8**

Since claims 2 and 8 depend upon claim 1, Applicants submit that they are patentable at least by virtue of their dependency.

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<sup>2</sup> See Col. 1, lines 42-47 of Linkola (pointing out that "a PLMN area" means "the geographical area covered by one network.").

**Claim 28**

Since claim 28 contains features that are similar to the features recited in claim 1, Applicants submit that claim 28 is allowable over Linkola for at least reasons analogous to those discussed above for claim 1. That is to say, Linkola fails to teach or suggest a limiter limiting communications of a portable communications terminal when the portable communications terminal is within a use prohibition area where communications of the portable communications terminal is not allowed, the prohibition area being a portion of a cell zone, as recited in claim 28.

Further, Applicants submit that Linkola fails to teach or suggest a portable communications terminal comprising, *inter alia*, a disconnect processor which is operable to disconnect communications of a portable communications terminal when receiving external disconnect instructions from a communication limiter, as recited in claim 28. As discussed by the Examiner, Linkola teaches a connection exchange part (33) which disconnects the connection of a mobile station when it receives a command from an evaluation part (32). (See page 4 of the Office Action). However, since the evaluation part (32) and the connection exchange part (33) are located on a subscriber identity module (SIM) which is located within a mobile station,<sup>3</sup> Linkola merely teaches a connection exchange part (33) which disconnects a mobile station upon receipt of an *internal command* from the evaluation part (32). As such, Linkola fails to teach a

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<sup>3</sup> See Col. 11, lines 24-25 of Linkola noting that the “different parts of the invention” (i.e., the location part (31), the evaluation part (32), and the connection exchange part (33)) “are implemented on the subscriber identity module SIM.”; See also Col. 3, lines 24-28 of Linkola explaining that a mobile station is formed of two parts, namely “by the mobile equipment (ME) and by the subscriber identity module (SIM),” so that the “functioning of the mobile station MS is formed only by inserting the SIM module into the mobile equipment ME.”

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portable communications terminal comprising *inter alia*, a disconnection processor which is operable to disconnect communications of the portable communications terminal when receiving external disconnect instructions from a communication limiter, as required by claim 28.

For at least the above reasons, Applicants submit that Linkola does not anticipate claim 28 and respectfully requests the Examiner to reconsider and withdraw the § 102(e) rejection of claim 28.

#### **Claims 29 & 31**

Since claims 29 and 31 depend upon claim 28, Applicants submit that they are patentable at least by virtue of their dependency.

#### **V. Rejection under 35 U.S.C. § 102(e) over Andersson**

Claims 10, 16 and 22 stand rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by Andersson et al. (U.S. Patent No. 6,230,017). For the following reasons, Applicants respectfully traverse this rejection.

#### **Claim 10**

With respect to claim 10, Andersson fails to disclose, teach, or otherwise suggest a home location register comprising a means for limiting communications of a user terminal when the user terminal is within a use prohibition area, where communications of the user terminal is not allowed, the prohibition area being in a cell zone.

The Examiner alleges that column 4, lines 48-60 of Andersson teaches the features recited in claim 10. Notwithstanding the Examiner's contention, Andersson merely teaches a Home Location Register (HLR) (24) which stores geographical data in a data base. The stored

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data is used to “manage subscription information for mobile subscribers belonging to a specific telecommunications operator.” (Col. 4, lines 48-51). More particularly, the HLR (24) described by Andersson, stores data corresponding to the cells (i.e., geographic areas) in which a mobile station may operate. (See Figure 2A of Andersson which shows an allowed cells list (112) within record (100A)).

With this in mind, Andersson describes that a mobile subscriber can utilize his/her mobile station to place a call or receive a call so long as the subscriber is within an allowed cell (which corresponds to cells specified in the allowed cells list (112)). (Col. 6, lines 52-54). On the other hand, when the mobile station travels into a cell that is not stored within the allowed cells list (112), the mobile station becomes non-operational. (Col. 6, lines 64-65 & Col. 7, lines 2-5).

As demonstrated, Andersson is directed to an HLR (24) which stores geographical information corresponding to subscription information. (See Abstract & Col. 4, lines 48-50). However, the HLR (24) described by Andersson does not disclose a means for limiting communications of a user terminal when the user terminal is located within a use prohibition area, the prohibition area being a portion of a cell zone, as recited by claim 10.

For at least this reason, Andersson fails to disclose, teach or otherwise suggest the features recited in claim 10. Accordingly, Applicants respectfully request the Examiner to withdraw the § 102(e) rejection of claim 10.

**Claim 16**

Since claim 16 contains features that are similar to the features recited in claim 10, Applicants submit that claim 16 is allowable over Andersson et al. for at least reasons analogous to those discussed above for claim 10.

**Claim 22**

With respect to claim 22, Applicants respectfully submit that the Examiner failed to provide any basis for the rejection of claim 22 within the Office Action. (*See* page 5 of the Office Action). Only the limitations of claims 10 and 16 were addressed. If the Examiner intends to maintain this rejection, as it applies to claim 22 in any future action, he or she is requested to provide explicit bases for the rejection on the record. Further, since no specific grounds of rejection have been asserted in regard to this particular rejection with respect to claim 22, any future rejection would be considered a *new ground of rejection* for purposes of a response.

Despite the fact that the Examiner failed to provide a basis for the rejection of claim 22, Applicants submit that claim 22 is patentable over the cited prior art because Andersson, is totally silent on the matter of a computer program executing a process of limiting communications of a user terminal in accordance with a location of the user terminal, as required by claim 22. Accordingly, Andersson does not teach, suggest or otherwise disclose the features recited in claim 22. For this additional reason, Applicants respectfully request withdrawal of the § 102(e) rejection of claim 22.



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**VI. Rejection under 35 U.S.C. § 103(a) over Linkola in view of Valentine**

Claim 3 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Linkola as applied to claim 2 above, and in view of Valentine et al. (U.S. Patent No. 6,567,668).

Additionally, claims 11, 17 and 23 stand rejected for the reasons submitted for claims 2 and 3.

Applicants respectfully traverse these rejections.

**Claim 3**

Applicants submit that claim 3 is patentable at least by virtue of its dependence on claim 1 since Valentine fails to suggest at least a communication limiter, which identifies whether the location of a user terminal is within a use prohibition area, where communications of the user terminal are not allowed, the prohibition area being within a portion of a cell zone, as recited in claim 1. Accordingly, Applicants respectfully request the Examiner to withdraw the § 103(a) rejection of claim 3.

**Claim 11**

Applicants submit that claim 11 is patentable at least by virtue of its dependence on claim 10 since the combination of Linkola and Valentine does not cure the deficient teachings of Andersson given that none of the cited references suggest at least a means for limiting communications of a user terminal when the user terminal is within a use prohibition area, the prohibition area being within a portion of a cell zone, as recited in claim 10. Accordingly, Applicants respectfully request the Examiner to withdraw the § 103(a) rejection of claim 11.

**Claim 17**

Applicants submit that claim 17 is patentable at least by virtue of its dependence on claim 16 since the combination of Linkola and Valentine does not cure the deficient teachings of Andersson given that none of the cited references suggest at least a method comprising the step of limiting communications of a user terminal when the user terminal is within a use prohibition area, the prohibition area being within a portion of a cell zone, as recited in claim 16. Accordingly, Applicants respectfully request the Examiner to withdraw the § 103(a) rejection of claim 17.

**Claim 23**

Applicants submit that claim 23 is patentable at least by virtue of its dependence on claim 22 since the combination of Linkola and Valentine does not cure the deficient teachings of Andersson given that none of the cited references suggest at least a control program executing a process of limiting communications of a user terminal in accordance with a location of the user terminal, as recited in claim 22. Accordingly, Applicants respectfully request the Examiner to withdraw the § 103(a) rejection of claim 23.

**VII. Rejection under 35 U.S.C. § 103(a) over Linkola in view of Andersson**

Claim 9 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Linkola as applied to claim 2, and in view of Andersson. Applicants respectfully traverse this rejection.

Applicants submit that claim 9 is patentable at least by virtue of its dependence on claim 1 since Andersson fails to suggest at least a communication limiter, which identifies whether the location of a user terminal is within a use prohibition area, where communications of the user

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terminal are not allowed, the prohibition area being within a portion of a cell zone, as recited in claim 1. Accordingly, Applicants respectfully request the Examiner to withdraw the § 103(a) rejection of claim 9.

#### **VIII. Allowable Subject Matter**

The Examiner has indicated that claims 4-7, 12-15, 18-21, 24-27, and 30 would be allowable if rewritten in independent form. Since the prior art rejections of the base claims have been overcome, Applicants submit that claims 4-7, 12-15, 18-21, 24-27, and 30 are allowable.

#### **IX. New Claims**

For additional claim coverage merited by the scope of the invention, Applicants have added new claims 32-33. Applicants submit that the prior art does not disclose, teach, or otherwise suggest the combination of features contained therein.

#### **X. Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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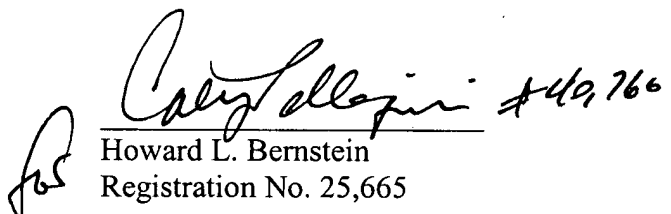
Respectfully submitted,

SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

WASHINGTON OFFICE

**23373**

CUSTOMER NUMBER

 *Howard L. Bernstein #49,766*  
Howard L. Bernstein  
Registration No. 25,665

Date: December 29, 2004